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IN THE

Supreme Court of the United States

OCTOBER TERM 1949

No. 681

JUDSON DUNAWAY CORPORATION,
Petitioner,

vs.

THE HYGIENIC PRODUCTS COMPANY,
Respondent.

CROSS-PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

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CROSS-PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT *PRAYED FOR ONLY IN THE EVENT THAT CERTIORARI IS GRANTED IN NO.* 672

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, Judson Dunaway Corporation, respectfully prays that, in the event that the petition for writ of certiorari by The Hygienic Products Company, No. 672, to review the judgment of the Court of Appeals for the First Circuit in the case brought by The Hygienic Products Company against petitioner is granted, another writ of certiorari be granted to review the holding by said court that respondent's registered trade-marks are valid and its consequent refusal to hold that respondent's trade-mark registrations should be cancelled pursuant to the Trade-mark Act of 1946, and in that behalf petitioner respectfully represents:

Respondent commenced this action in the District Court for the District of New Hampshire on May 31, 1947, charging unfair competition and infringement of six registered

trade-marks. The trade-marks involved are picture marks and the charged infringement and unfair competition was based upon respondent's use, in its advertising, of pictures alleged to be similar. The District Court held for respondent, concluding that its registered trade-marks were valid, that they had been infringed, and that petitioner had competed unfairly with respondent. An injunction was granted. Petitioner thereupon appealed to the Court of Appeals for the First Circuit which, although holding that respondent's pictures constituted valid trade-marks and were properly registered as such, found no trade-mark infringement or unfair competition, vacated the judgment of the District Court, and remanded the case for the entry of judgment for petitioner. The judgment of the Court of Appeals was entered on December 15, 1949.

Respondent The Hygienic Products Company is petitioning this Court for a writ of certiorari and petitioner Judson Dunaway Corporation files this *cross-petition* to bring before this Court the issue of trade-mark validity and the applicability of the Trade-mark Act of 1946, in the event that respondent's petition should be granted.

Summary and Short Statement of the Matter Involved

The facts, in so far as they are material to this petition, may be briefly stated as follows:

Respondent (plaintiff below) has been engaged since 1911 in the manufacture and sale throughout the United States of a toilet bowl cleaner containing bisulphate of soda, sodium chloride and powdered soapstone. As used, this product is poured into a toilet bowl where, in contact with water, it cleans by chemical action. It was covered by two patents which respondent obtained in 1912 and 1915 respectively (Exhs. H-1, R. 74, 257-9 and H-2, R. 75, 260-3).

Respondent adopted the term SANI-FLUSH as the trade-mark for its product about 1911 and has since used that

designation. Respondent's product is sold in cans which bear the pictorial representation of a toilet bowl and a female figure standing beside the toilet bowl and holding in her hand a can of SANI-FLUSH from which material is falling into the toilet bowl.

Respondent has asserted trade-mark rights in the pictorial representation in addition to its trade-mark rights in the designation SANI-FLUSH. The present cause of action is based upon its claim of a perpetual exclusive right to use this pictorial representation of its product and of its utility, on the theory that it is a valid trade-mark.

From time to time respondent has changed the style of this pictorial representation and has secured a number of certificates of registration therefor from the United States Patent Office (Exhs. A-1 to A-7, R. 56, 57, 237-243). None of the pictorial representations shown in registrations Exhibits A-1 to A-5 (R. 56-7, 237-241) have been used by plaintiff on its product since about 1938 (R. 123).

There are seven registrations as follows:

Certificate 108,251, dated in 1916, shows an old-fashioned housemaid pouring from a can into a toilet bowl (Exh. A-1, R. 56, 237).

Certificates 263,929, dated in 1929, and 298,650, dated in 1932, are alike except for the words SANI-FLUSH appearing in the former. They both show a more up to date housemaid pouring from a can into a toilet bowl (Exhs. A-2 and A-3, R. 56, 238, 239).

Certificates 372,096 and 372,097, both dated in 1939, are alike except for the inclusion of the words SANI-FLUSH in the latter. Both show a young housewife wearing an apron and in the act of pouring from a can into a toilet bowl (Exhs. A-4 and A-5, R. 57, 240, 241).

Certificates 374,844 and 374,845, both dated in 1940, are alike except that the name SANI-FLUSH appears in the latter. They both show a photographic portrait of a certain rather matronly appearing woman named Ruby Sleeth in the act of pouring from a can into a toilet bowl (Exhs. A-6 and A-7, R. 57, 242, 243).

In 1937 petitioner (defendant below) commenced the distribution under its own registered trade-mark VANISH of a product of the type disclosed in respondent's expired patents to be used as a toilet bowl cleaner and bathroom deodorant (R. 167).

In advertising its product petitioner used a display card (Exh. K, R. 93, 170) which shows a bathroom background including tiled walls, lavatory, shower, shower curtains, and toilet bowl, and a woman holding a can of VANISH over the toilet bowl with material falling from the can into the toilet bowl. It also used consumer leaflets (Exh. C, R. 58, 248, 249) bearing a picture of a bathroom with tiled walls, bath tub, shower curtains and toilet bowl, and a woman holding a can of VANISH over the toilet bowl with material falling from the can into the toilet bowl.

Petitioner caused to be published in a number of newspapers an advertisement of its product VANISH (Exh. E, R. 58, 253) illustrated with the pictorial representation of a woman holding a can of VANISH over a toilet bowl with material falling from the can into the toilet bowl and another newspaper advertisement (Exh. E-1, R. 61, 253) illustrated with the representation of a toilet bowl, a can of VANISH suspended over the toilet bowl with material falling from the can into the toilet bowl and merely a hand holding the can.

The charges of trade-mark infringement and unfair competition were based solely upon petitioner's use of the aforesaid advertising material.

In the District Court and in the Court of Appeals petitioner made the following points:

1. That respondent's pictorial representations of its product and of the manner of its use do not constitute good trade-marks at common law or under the Federal statutes because they are descriptive.

2. That all of respondent's trade-mark registrations are invalid because the marks registered thereby are de-

scriptive and because the marks registered by Nos. 108,251, 263,929, 298,650, 372,096 and 372,097 have been abandoned.

3. That the Trade-mark Act of 1946 applies and the District Court had jurisdiction to direct, and should have directed, cancellation of respondent's trade-mark registrations.

4. That even if any one of respondent's trade-mark registrations possesses some measure of validity, the petitioner has not infringed.

5. That petitioner in its advertising complained of merely employed a widely used type of illustration to show the public what its product is and how its product is to be used without intending or accomplishing any trade-mark infringement or unfair competition with respondent.

6. That by reason of the outstanding differences in appearance between respondent's package and petitioner's package and by reason of petitioner's prominent use of its commercial signature, namely, its own trade-mark VANISH, there is no likelihood of deception or confusion and no unfair competition with respondent.

7. That the complaint should be dismissed, the relief demanded by the counterclaim should be granted, and petitioner should be awarded the costs of this action in the District Court and in the Court of Appeals.

The Court of Appeals held for petitioner on Points 4, 5, 6 and 7 except that it refused the relief demanded by the counterclaim, and held for respondent on Points 1 and 2 except that it did not pass on the issue of abandonment, and declined to rule on Point 3.

Jurisdiction

The jurisdiction of this Court to issue the writ of certiorari applied for is predicated upon United States Code

Title 28 Section 1254. The Court of Appeals had jurisdiction under Title 28 Section 1291, and the District Court under Title 28 Sections 1332 and 1338 because this is an action for trade-mark infringement and unfair competition between citizens of different states, namely, Ohio and New Hampshire.

Questions Presented

The questions presented are:

(1) The validity, as a trade-mark, of a pictorial representation of a product showing the product in use, giving pictorial directions for its use and thereby describing the character of the product.

(2) The abandonment of trade-mark rights by non-user thereof, a different trade-mark having been substituted therefor.

(3) The applicability of Section 37 of the Trade-mark Act of 1946 (United States Code Title 15 Section 1119) to actions pending on July 5, 1947, the effective date of said Act.

Reasons Relied on for the Allowance of the Writ

(1) Petitioner has ascertained that respondent The Hygienic Products Company is about to file a petition for writ of certiorari, but this cross-petition has been prepared without having seen respondent's petition. The rules of this Court state that only the questions specifically brought forward by a petition for writ of certiorari will be considered. It is not to be expected that respondent herein would, in its petition, raise any question concerning the validity of its trade-marks, the abandonment thereof or the applicability of the Trade-mark Act of 1946. Therefore, and in order that these fundamental questions may prop-

erly be brought before this Court in the event that respondent's petition is granted, this petition should also be granted.

(2) So far as can be presently ascertained, this Court has not passed specifically upon the validity of a pictorial trade-mark descriptive of the character of a product, such as is here involved, or upon the right of one producer to secure a competitive advantage over another in the use of advertising material bearing a pictorial representation of the product and the manner of its use on the theory that the former has acquired perpetual exclusive rights in such pictorial representation under the trade-mark laws. These are questions of public importance which should be settled by this Court because if one producer by adopting and using a picture mark illustrating how, where, by whom and for what purpose his product is most commonly used, can attempt to monopolize the use of such matter in advertising, then every other manufacturer of a like product will either be excluded in perpetuity from so advertising its manner of use or be compelled to defend its right to use such advertising matter, as petitioner did in this case.

(3) The law is well settled that abandonment of trade-mark rights does not necessarily follow from non-user, the determining factor being one of intention, but with the exception of one Court of Appeals case upon which petitioner relied, there does not appear to be any authoritative pronouncement upon abandonment by non-user coupled with the substitution of another and different mark in the face of the non-user's denial of any intent to abandon. Here again is an important point of trade-mark law which should have the consideration of this Court.

(4) The Trade-mark Act of 1946 provides that in any action involving a registered trade-mark, the District Court may determine the right to registration and order the cancellation of registrations if such relief is warranted. Petitioner counterclaimed for such relief. The District Court,

although finding that the trade-marks were valid, held that the 1946 Act did not apply because this case was pending when that Act went into effect. The Act in question states that "except as otherwise herein specifically provided" it shall not affect any suit, proceeding or appeal then pending, but it also says that registrations under the Act of February 20, 1905 shall be subject to the provisions of the 1946 Act to the same extent and with the same force and effect as though registered thereunder, except for certain provisions not presently involved. This presents a question of statutory construction which should have an authoritative ruling from this Court.

If this Court should issue a writ of certiorari as prayed for by The Hygienic Products Company, but which is opposed by the petitioner herein, your petitioner respectfully requests that the Court grant this cross-petition so that at least the fundamental issue in the case, namely, the validity of respondent's alleged trade-marks, may be before it and so that your petitioner will be free to urge the complete invalidity of respondent's trade-marks and the registrations thereof as it did below.

Respectfully submitted,

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March 10, 1950